

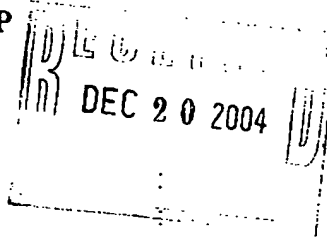


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Paper No. 83

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OFFICE OF PETITIONS
ON PETITION

In re Application of
Rapoport
Application No. 08/482,402
Filed: June 7, 1995 (Last CPA filed June 13, 2000)
Attorney Docket No. 102105.151CI

4-1697 dw3

This is a decision on the petition under 37 CFR 1.137(b) filed September 4, 2003, and supplemented December 3, 2004.

The petition is granted.

Facts and Procedural History:

A Notice of Allowance and Issue Fee Due was mailed to applicant on May 1, 2002. The Notice set a three month statutory period for payment of the Issue Fee. Therefore, the issue fee was due on or before August 1, 2002.

The application became abandoned on August 2, 2002, due to petitioner's failure to timely pay the issue fee.

On September 16, 2002, the Office mailed a Notice of Abandonment, which stated the application had become abandoned because the issue fee had not been received by the Office.

On October 1, 2002, petitioner filed a petition to withdraw the holding of abandonment alleging the issue fee transmittal form had been timely filed.

The file and petition were physically received in the Technology Center on October 9, 2002.

On December 2, 2002, the Technology Center mailed a decision dismissing the petition. The decision informed petitioner that the Office had received the issue fee transmittal form but the Office was unable to charge the issue fee due to insufficient funds in the deposit account. The decision suggested petitioner file a petition under 37 CFR 1.137(b).

On December 27, 2002, petitioner filed a request for reconsideration of the December 2, 2002 decision and in the alternative, filed a petition under 37 CFR 1.137(a) and 37 CFR 1.137(b).

An additional petition was filed January 14, 2003. The petition requested the "paper filed on December 27 be superseded by the present filing." Petitioner argued the application could not be abandoned because the issue fee was charged to petitioner's deposit account on October 3, 2002. A decision was mailed on May 7, 2003, dismissing the petition for reconsideration under 37 CFR 1.181 and dismissing the petition under 37 CFR 1.137(a). The merits of the alternative petition under 37 CFR 1.137(b) were not considered. The decision failed to take into consideration the January 14, 2003 petition because the petition had not been matched with the file as of May 7, 2003.

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A petition was filed on June 13, 2003, requesting consideration of the merits of the January 14, 2003 petition. The petition provided further arguments alleging the application is not abandoned. In addition, the petitioned requested waiver of the rules under 37 CFR 1.183.

The petition under 37 CFR 1.183 was dismissed on July 8, 2003. The file was forwarded to the Technology Center for consideration of the petition to withdraw the holding of abandonment. The decision stated,

The record indicates that the May 7, 2003 decision did not take into consideration the merits of the petition filed on January 14, 2003. For example, the Office did not consider petitioner's arguments that the holding of abandonment was withdrawn automatically when the Office charged the issue fee to petitioner's deposit account. Therefore, the file will be forwarded to the Technology Center to consider the petition filed on January 14, 2003, and the instant petition, to the extent the petitions request withdrawal of the holding of abandonment. . . .

The file is now being forwarded to Technology Center 1600 for the consideration of the petition filed on January 14, 2003, and the instant petition, to the extent the petitions request withdrawal of the holding of abandonment.

The instant petition under 37 CFR 1.137(b) was filed on September 4, 2003. The instant petition does not explicitly request the Office not consider the previous requests to withdraw the holding of abandonment. Therefore, the Technology Center should have considered the request to withdraw the holding of abandonment, and if such a request was dismissed, forwarded the file to the Office of Petitions to consider the petition under 37 CFR 1.137(b).

The Technology Center received the file but did not consider petitioner's arguments that the holding of abandonment should be withdrawn. The Technology Center did not consider the merits of the instant petition or send the file to the Office of Petitions for consideration of the merits of the petition. Petitioner filed a status inquiry on December 15, 2003. The Office did not respond to the status inquiry. During January of 2004, the Technology Center sent the file to Files Repository to be stored as an abandoned file.

On May 26, 2004, a second status inquiry was filed by petitioner. The file was ordered from Files Repository and sent to the Technology Center during June of 2004.

On December 3, 2004, petitioner filed a "Re-Transmittal of Previously Transmitted Petition for Revival of Application for Patent" which included a copy of the papers filed September 4, 2004. In response, the Office of Petitions ordered the file and the file was received from the Technology Center on December 10, 2004.

Analysis:

Per a telephone conversation with attorney Donald Stout on December 18, 2004, the Office understands petitioner wishes for the Office to disregard previous requests to withdraw the holding of abandonment and to consider only the instant petition under 37 CFR 1.137(b).

A grantable petition under 37 CFR 1.137(b) must be accompanied by:

- (1) the required reply,
- (2) the petition fee,
- (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, and
- (4) a terminal disclaimer and fee if the application was filed on or before June 8, 1995 or if the application is a design application.

As to (1), the required reply is the submission of the issue fee. The issue fee of \$1,280 was submitted during October of 2002. Therefore, requirement (1) has been met.

As to (2), the petition fee of \$1,300 will be charged to petitioner's deposit account per the fee authorization filed on September 4, 2003.

As to (3), the proper statement has been submitted.

As to (4), a Terminal Disclaimer is **not** required. A terminal disclaimer is required when an application was filed prior to June 8, 1995. A Continuation Prosecution Application (CPA) was filed June 13, 2000. Although the CPA uses the same application number as an application which was filed prior to June 8, 1994, the CPA is a new and separate application. Therefore, the Terminal Disclaimer has not been accepted and will not be entered, but will be placed in the application file. The fee for filing a Terminal Disclaimer will not be charged to petitioner's deposit account.

Petitioner has met the requirements to revive the above-identified application pursuant to 37 CFR 1.137(b). Therefore, the petition is granted and the application is revived.

The file is now being forwarded to Publishing Division for processing into a patent.

Telephone inquiries may be directed to Petitions Attorney Steven Brantley at (571) 272-3203.



Charles Steven Brantley
Petitions Attorney
Office of Petitions